



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No.: PTO-P-2011-0046]

Request for Comments on Preparation of Patent Applications

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO) is seeking to improve the quality of issued patents. In this notice, the USPTO is focusing on potential practices that applicants can employ at the drafting stage of a patent application in order to facilitate examination and bring more certainty to the scope of issued patents. To that end, the USPTO is requesting input from interested members of the public on the specific practices set forth in the “Topics for Public Comment” section below. While this notice is directed to potential practices that applicants can employ, the USPTO also plans to issue a separate notice building on internal initiatives and further identifying potential practices the Office can employ to also facilitate examination and bring more certainty to the scope of issued patents. The USPTO intends to publish the separate notice subsequent to its review of comments received responsive to the present notice.

On January 3, 2013, the USPTO published a notice announcing the formation of a partnership with the software community to enhance the quality of software-related patents (Software Partnership). See Request for Comments and Notice of Roundtable Events for Partnership for Enhancement of Quality of Software-Related Patents, 78 FR 292 (Jan. 3, 2013). The Software Partnership notice seeks public comment on specific topics related to enhancing the quality of software-related patents, and announces two roundtable events, which will not only offer participants an opportunity to provide oral comments on the topics presented in the Software Partnership notice but also on the topics set forth in the present notice, to the extent they apply to software-related patents.

COMMENT DEADLINE: To be assured of consideration, written comments must be received on or before March 15, 2013. No public hearing will be held.

ADDRESSES: Written comments should be sent by electronic mail addressed to QualityApplications_Comments@uspto.gov. Comments may also be submitted by mail addressed to: Mail Stop Comments - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Nicole D. Haines. Although comments may be submitted by mail, the USPTO prefers to receive comments via electronic mail.

The comments will be available for public inspection at the Office of the Commissioner for Patents, located in Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia, and will be available via the USPTO Internet Web site (address: <http://www.uspto.gov>).

Because comments will be available for public inspection, information that is not desired to be made public, such as an address or phone number, should not be included in the comments.

FURTHER INFORMATION: For further information about this request, contact Nicole D. Haines, Legal Advisor, at (571) 272-7717; Kathleen Kahler Fonda, Senior Legal Advisor, at (571) 272-7754; or Matthew J. Sked, Legal Advisor, at (571) 272-7627, of the Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy. General patent practice inquiries may be directed to the Office of Patent Legal Administration, by telephone at (571) 272-7701, or by electronic mail at PatentPractice@uspto.gov.

SUPPLEMENTARY INFORMATION: The USPTO is committed to enhancing the quality of issued patents and the efficiency of patent prosecution. To further this goal, the USPTO has undertaken a number of internal initiatives over the past several years. For example, the USPTO routinely provides its examiners with training on topics such as obviousness under 35 U.S.C. 103 and statutory subject matter under 35 U.S.C. 101 in order to provide clear guidance regarding the impact of significant new case law on the patent examination process. Patent examiners also receive training on 35 U.S.C. 112 to address concerns about the proper interpretation of claim language, the clarity of claim terms, and the adequacy of the specification to support functional claim limitations. Additionally, the USPTO has implemented a new quality measurement system that comprehensively evaluates examination quality. One component of this system is an

external quality survey that obtains input from applicants and practitioners on the perceived quality of the patent examination process.

The USPTO has also undertaken initiatives that involve working with the public to enhance the examination process. For example, examiners participate in workshops focusing on compact prosecution and holding effective interviews with applicants. Also, the USPTO works with experts in industry to provide technical training for patent examiners and updates on developments and innovations in their field. This training initiative enhances examiners' insight in their fields, enabling them to better understand intended claim scope and make better informed patentability decisions.

I. Purpose of this Notice

This notice is directed to furthering the Office's dialog with the public about ways to enhance patent quality. Specifically, the topics set forth in the "Topics for Public Comment" section of this notice are potential practice changes that applicants can employ to augment the quality of issued patents. The public is invited to comment on whether these practices should be employed by applicants at the drafting stage of a patent application in order to facilitate examination and bring more certainty to the scope of issued patents.

II. Topics for Public Comment

The USPTO is seeking input on whether the following practices should be used by applicants during the preparation of an application to place the application in a better condition for examination. When patent applications are filed in the best possible condition for examination, examiners can better focus the examination on substantive patentability issues. Specifically, the USPTO is seeking input on whether adoption of the following practices by applicants early in the process would assist the public in determining the scope of claims as well as the meaning of claim terms in the specification after a patent is granted.

A. Clarifying the scope of the claims

The boundaries of patent protected subject matter should be clearly delineated and the scope of each claim made clear on filing of a patent application to facilitate examination and the publishing and patenting of claims that best serve the public notice function. In this regard, the USPTO is seeking public comment on advantages and disadvantages of applicants employing the following practices when preparing their patent applications:

1. Presenting claims in a multi-part format by way of a standardized template that places each claim component in separate, clearly marked, and designated fields. For instance, a template may facilitate drafting and review of claims by separately delineating each claim component into separate fields for the preamble, transitional phrase, and each particular claim limitation.

2. Identifying corresponding support in the specification for each of the claim limitations utilizing, for example, a claim chart or the standardized template described above. This practice could be particularly beneficial where claims are amended or where a continuing application (continuation, divisional, continuation-in-part) is filed.
3. Indicating whether examples in the specification are intended to be limiting or merely illustrative.
4. Identifying whether the claim preamble is intended to be a limitation on claim scope.
5. Expressly identifying clauses within particular claim limitations for which the inventor intends to invoke 35 U.S.C. 112(f) and pointing out where in the specification corresponding structures, materials, or acts are disclosed that are linked to the identified 35 U.S.C. 112(f) claim limitations.¹
6. Using textual and graphical notation systems known in the art to disclose algorithms in support of computer-implemented claim limitations, such as C-like pseudo-code or XML-like schemas for textual notation and Unified Modeling Language (UML) for graphical notation.

¹ 35 U.S.C. 112(f) replaces 35 U.S.C. 112, ¶ 6 as the section of the statute pertaining to means-plus-function limitations for applications filed on or after September 16, 2012. See Leahy-Smith America Invents Act, Pub. L. No. 112-29, § 4(c)(6), 125 Stat. 284, 296 (2011).

B. Clarifying the meaning of claim terms in the specification

The best source for determining the meaning of a claim term is the specification. See Phillips v. AWH Corp., 415 F.3d 1303, 1315-16 (Fed. Cir. 2005). The specification should clearly define the claim language so that the scope of each claim can readily be determined, ensuring the public notice function of the patent claims is best served. In this regard, the USPTO is seeking public comments on advantages and disadvantages of applicants employing the following practices when preparing their patent applications:

1. Indicating whether terms of degree – such as substantially, approximately, about, essentially – have a lay or technical meaning and explaining the scope of such terms.
2. Including in the specification a glossary of potentially ambiguous, distinctive, and specialized terms used in the specification and/or claims, particularly for inventions related to certain technologies, such as software.
3. Designating, at the time of filing the application, a default dictionary or dictionaries (e.g., a technical dictionary and a non-technical dictionary) to be used in ascertaining the meaning of the claim terms.

III. Guidelines for Written Comments

As discussed previously, the USPTO prefers to receive comments via electronic mail. Information provided in response to this request for comments will be made part of a public record and may be available via the Internet. In view of this, parties should not submit information that they do not wish to be publicly disclosed or made electronically accessible. Parties who would like to rely on confidential information to illustrate a point are requested to summarize or otherwise submit the information in a way that will permit its public disclosure.

Date: January 10, 2013

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Date: 01/15/2013]

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